IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

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ARBUTUS BIOPHARMA CORPORATION, ET AL.	:	CIVIL ACTION NO. 22-252
v.	:	TELEPHONE CONFERENCE
MODERNA, ET AL.	:	

James A. Byrne U.S. Courthouse
601 Market Street
Philadelphia, PA 19106
May 19, 2025
Commencing at 3:05 p.m.

BEFORE THE HONORABLE MITCHELL S. GOLDBERG

APPEARANCES:

FOR THE PLAINTIFFS:
WILLIAMS & CONNOLLY, LLP
BY: DAVID I. BERL, ESQUIRE
680 Maine Avenue SW
Washington, DC 20024
(202) 434-5491
dberl@wc.com

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Cherilyn M. McCollum, CCR-NJ, RPR
Official Court Reporter
Cherilyn_McCollum@paed.uscourts.gov

Proceedings taken stenographically and prepared utilizing computer-aided transcription

APPEARANCES CONTINUED:

FOR THE DEFENDANTS:
KIRKLAND ELLIS, LLP
BY: MARK C. McLENNAN, ESQUIRE
601 Lexington Avenue
New York, NY 10022
(212) 446-4800
mark.mclennan@kirkland.com

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(Proceeding commences at 3:05 p.m.)

THE COURT: So what I want to make clear, which maybe I didn't last time and I sort of wasn't as clear as I could be last patent jury trial I handled, where I required narrowing of claims in patents. I don't view, unless I got this concept wrong, but I don't view narrowing, so we'll use the patents here, to three, which is what my order was, to constitute a proclamation the other three that aren't picked by the plaintiff somehow amounts to a forfeiture of the plaintiffs' right to pursue infringement on the three that they don't pick. And I'm happy to hear, Mr. Berl, if I got this concept wrong, but I sort of view it as, well, we've got a lot of claims on a lot of patents, patent is inherently complicated for a fact finder, I have other cases on my docket, I'm a visiting judge in this case, and there has got to be an efficient way to present this information that's incredibly, incredibly complicated, so given those factors, I'm allowed to exercise my discretion and narrow those claims on patents. But that doesn't mean that you've lost your right to, after the dust settles on the first trial, which is sort of a bellwether trial in a way, you don't lose your right to still say the ones that weren't picked aren't still infringed. There has been no ruling on that.

Mr. Berl, in that general concept, are we on the same page? I didn't spell it out as much the last time we were

together because I didn't think it was necessary. But are we on the same page?

MR. BERL: I guess I'm not entirely sure whether we are or not, Your Honor, because it has never been entirely clear to me based on the case law of what the status is of non-selected claims for patents. I think the general idea in most of these cases, as I read them at least, is that the patents or claims that are selected generally address all the legal and factual issues so they will resolve all of the issues with respect to the non-narrowed patents so that they, in a sense, all rise and fall together, and therefore, if the plaintiff wins on the selected patents, the narrow patents --

THE COURT: Suppose the claims, just for sake of discussion -- I mean, I sort of disagree with that concept, and I'm not saying I know what the case law answer is, but suppose you have -- I'm just picking a number just to make a point -- like 15 claims in a complicated case. You can't expect a jury to make a determination on 15 separate infringement claims. And if they don't all mesh together, in my view, if I said, well, I've got a month and I think based on an intelligent attestment that only seven of these claims can be litigated on infringement alone, where does that proclamation say that you lose your right to the other seven? Whether we're on the same page or not, I'm saying to you, I don't view it that way. I'm the judge in this case, and I don't view it as a waiver at all

of your rights.

MR. BERL: Understood. Understood, Your Honor.

And I think the issue from our perspective is that everyone agrees about how many claims the jury, fact finder can digest. We proposed six, Moderna proposed six for trial, and Your Honor adopted six. So in our view, the information that's going to be presented to the jury will be about those six claims. And whether there are three patents at trial or four patents at trial or two patents at trial, that information will be the same for the jury. They'll assess our three arguments on infringement, which we laid out briefly on Friday. There was doctrine of equivalents theory and then there are two literal infringement theories, and that will be the same. So the difference in terms of patent to patent is not about what information the jury is going to have to hear about and digest but, rather, the legal import of the jury's rulings just because the patents differ from each other in terms of the estoppel issues, both IPR estoppel and garden variety --

THE COURT: Let me ask you to educate me on a basic patent concept I think I'm missing. So if you are saying six claims we agree -- that's me putting aside the invalidity issues that Moderna was going to raise -- but six claims go to the jury, Judge, and it's not going to matter which patent they come from, I mean, I don't understand why if you have one -- say, Here is our claim, members of the jury, here is what it

says, and here is why Moderna infringes, and you are doing it for six separate claims, why did you need six separate patents? I mean, did they come -- and one is -- five you told me are under one family with the same expiration date.

MR. BERL: That's right. There are five under one family, so let's talk about those. For the most part, the claims are similar, but they differ in really important ways. To take one example, one of those patents issued after the beginning of Moderna's sales. So, for example, if we assert that patent rather than the others, which happens to be our broadest patent where we claim the most infringement under most of our theories, that is our broadest patent, a third of the sales we can't even touch because they happened before the issuance of the patent and so --

THE COURT: I'm sorry to interrupt. Five in the one family, which I'm looking at the number now, everything except the '069?

MR. BERL: Everything except the '651.

THE COURT: I'm sorry. Okay. So the '378, the '435, the '668, the '359, and the '069 are all one family.

MR. BERL: Yes.

THE COURT: Don't all of them have the same expiration date?

MR. BERL: They have the same expiration date, but they don't have the same issuance date. And we're not allowed

to get damages before the issuance of the patent. And so a lot of Moderna's sales, for example, in late 2020, we can't recover under that patent because it hadn't issued yet, and yet that is our broadest patent. So we are, in a sense, having to choose between our broadest patent where we confirmed the most infringement in terms of the theories of literal infringement, for example, and trying to capture the late-2020 sales, which we can't do with this patent because it hadn't issued yet.

THE COURT: Would your view change if I would put in -- well, I'm on the record. I'm not making a ruling now. But would your view change if I were to say, I'm sticking with three patents and the same number of claims, motion for reconsideration is denied; however, it is understood that after the first trial, to the extent that Arbutus wants to continue to press other claims not litigated in the first trial, they retain that right to do so? Would your view change in all of this if I said that?

MR. BERL: I don't really think so, Your Honor. The reason is it is not clear to me how that would work. Because then -- I mean, would the jury's determination with respect to our literal infringement theories and doctrine of equivalents theories apply? And if so -- so for example --

THE COURT: No, it would -- to the extent the issues on liability are the same, it would be a -- I mean, I heard you say we're having trouble with this because we have a different

issuance date so our damages theory is different, and we would take what happened in the first trial and then give you, to the extent you had a different issuance date, give you a short and quick damages trial.

MR. BERL: I mean, I suppose that's just the same information -- I don't think our damages theories are different with respect to the issuance date as much as it is that the damages would only apply on the '378 after a certain date, so I guess that would create two trials where there is no more complexity in one trial. And so I just -- you know, I suppose that's better than nothing, but I think we can just do all six of these claims in one trial rather than splitting them into two and it would be much more efficient that way.

There are -- just to take another example, you know, all of these patent claims from the family you just read have all of these ranges in them. Sometimes the ranges say, you know, for one of them from three to 15, sometimes they say from four to 10, and so a different number of lots will infringe each of these different patents simply because of the numbers, you know, in Moderna's products in our testing of them. So it's the same issue presented to the jury: Do you agree with our version of the testing from Dr. Schuster or do you agree with Moderna's response? Do you agree with our theory or -- (audio distortion) -- and so the jury is going to have to decide those issues. The only difference is going to be -- (audio

distortion) --

THE COURT REPORTER: I'm sorry, counsel.

MR. BERL: -- what is the number in terms of damages that -- (audio distortion) --

THE COURT: Mr. Berl.

MR. BERL: -- so that we can try this case and get this done -- (audio distortion) --

THE COURT: Mr. Berl. Calling Mr. Berl.

MR. BERL: -- and then we can move on rather than saying, well, the jury got this and not this and try to -- (audio distortion) --

THE COURT: Can you hear me?

MR. BERL: -- and then have the trial on whatever claims, you know, or, I'm sorry, whatever patents did continue.

Again, we're fine just leaving it at six. You know, we don't worry about the other -- (audio distortion) -- we want to have one trial. And I think we can do that with six -- (audio distortion) -- so that the difference from patent to patent is all -- (audio distortion) --

THE COURT: Mr. Berl.

MR. BERL: -- in terms of damages and that's now -- (audio distortion) --

THE COURT: Mr. Berl.

MR. BERL: -- two patents close enough to make decisions between do we -- (audio distortion) -- aren't

productive in terms of the efficiency of the case and aren't fair in terms of the property rights.

THE COURT: Can you hear me, Mr. Berl?

MR. BERL: No. Sorry, I can't.

THE COURT: I said, "Can you hear me?" And you said, "No."

MR. BERL: Right. Right when you said that, I heard a faint voice. I think a button got pushed. I'm sorry, Your Honor.

THE COURT: Can you hear me now?

MR. BERL: I can, Your Honor.

THE COURT: Okay. Well, I was trying to stop you about five minutes ago because I couldn't hear a word you were saying and something happened, and I'm now worried that you haven't taken a breath in five minutes. Have you fainted? Are you okay?

MR. BERL: I'm here, Your Honor.

THE COURT: Okay. I didn't -- about -- literally about three minutes ago, the last time you started talking up until now, I could not hear a word you were saying. It was very blurred.

MR. BERL: I apologize.

THE COURT: It's a tech issue. It's not your fault.

Now give me the 30-second version of what you said in the last three minutes. Say it again.

MR. BERL: Sure. The 30-second version is that, in our view, having this done only once with one trial is the simplest and most efficient way to go forward because if we have -- (audio distortion) --

THE COURT REPORTER: Judge, I can't hear him again.

MR. BERL: -- the jury can be presented in a single trial with only six claims. Whether there are two patents, three patents, four patents -- (audio distortion) --

THE COURT: Mr. Berl, I can't hear you.

MR. BERL: -- totally different in terms of the number of patents is how much you get based on adjudication of the dispute. And so that's not going to add complexity to the trial. It would avoid a second trial -- (audio distortion) -- and that's what our strong preference -- (audio distortion) -- and be done with it and not deal with a second trial.

THE COURT: That was way more than 30 seconds, and I couldn't hear you again. You want to just hang up and dial back in or go on a different phone? Are you on your cell phone? What is going on?

MR. BERL: I am, Your Honor. Let me try to fix the problem.

THE COURT: Are you in your office? Can you go to a hardline?

MR. BERL: I don't have a hardline here, unfortunately.

THE COURT: Just so you know, everything you said in the last five minutes the court reporter I am sure -- could the court reporter hear Mr. Berl? Because I couldn't.

THE COURT REPORTER: I couldn't hear, and I did try to stop him, but he couldn't hear me. I don't think anyone could hear me.

THE COURT: I think his technical glitch is he can't hear through his phone.

I'm going to try to repeat what I think you said, which is we're trying to be efficient, we are -- we're good with the number of claims that you have narrowed it to, and if you make us pick three, we may have to do a second trial, and that's not efficient, we want a little more leeway to add more patents in than three, and that will be more efficient.

I mean, is that the gist of it?

MR. BERL: That is the gist. The one addendum is that the issues presented to the jury in terms of our infringement theories would be the same. Whether it is two patents or three patents or four patents, it's the same issues on infringement, so what happens then is the only difference is, when the jury decides those infringement issues, how much do we get in damages, so that's --

THE COURT: I understand. I understand your argument. All right. I get it.

So let me hear from Mr. McLennan.

MR. McLENNAN: Thank you, Your Honor.

So on this point about preclusion and what the impact would be on later cases and whether plaintiffs could just proceed in this in the new case, plaintiffs cited the case *In Re: Katz*, the Federal Circuit decision, which is informative to Your Honor's question. So in that case, when the court issued a narrowing order requiring a limit on the number of asserted claims, which also limited the asserted patents, the Federal Circuit approved of the procedure and agreed with the district court's decision that they would not allow the patentee to set up the -- basically, the unasserted claims and save those for another case. So I think it's very similar to this situation here where you are suggesting that possibly these patents could be asserted again. The Federal Circuit has already approved of a procedure where, yes, a district court does maintain the discretion to limit claims. And I don't have the cases at hand addressing the preclusion effects, but I believe are not too far off of what Mr. Berl was saying, that there would be some preclusion effect. But generally courts assume that plaintiff move forward with their strongest claims. You move forward with the claims you think are strongest on infringement and invalidity, and that's essentially the reason for the precluded effect in later cases.

On the number of patents --

THE COURT: Hold on. So are you saying you disagree

with my instinct that, if I held him to three and we had a trial, he would be able to maintain and ask for a trial on the other three? Are you disagreeing with that premise? It sounds like you are.

MR. McLENNAN: Your Honor, I don't think there is an absolute answer I can give you on the phone now.

THE COURT: Okay.

MR. McLENNAN: I think it's an issue that is quite complicated in the case law.

THE COURT: Okay. All right. Go ahead.

MR. McLENNAN: On the number of patents, counsel for plaintiffs referred to there being different issuance and expiry dates. So to the later-issued patents that they mentioned that was broader that issued during the pandemic, they could always, under the Court's order allowing them to move forward with three and then two patents, they could still present a case at trial and pick any one of the five other patents that were issued before the alleged infringement period began. They are not missing out on anything in terms of the damages window. There is no reason to proceed on all six patents through trial when there is only a difference in issuance date for one patent. That doesn't justify keeping more than two or three in the case.

And with the numbers that were presented in plaintiffs' brief asking for five and then four patents at trial, there is

no analysis whatsoever justifying why that particular number is any less prejudicial than the number that the Court's already ordered. There just wasn't a patent-by-patent analysis explaining how that could be justified. And I think other counsel for plaintiffs just say that the issues of infringement are the same between those patents. So if it is just about damages, they can still have their full damages window under the Court's current procedure.

THE COURT: Okay. You can respond. Go ahead.

MR. BERL: Yes. Let me respond to two points.

On the first one with respect to preclusion, what Mr. McLennan is saying is that the limiting of patents would be a draconian result because what they are --

THE COURT: No, he didn't say that. He said he wasn't sure. But go ahead.

MR. BERL: Okay. Or that it could be a draconian result. But with respect --

THE COURT: He didn't say that either, but go ahead.

MR. BERL: But with respect to the number of patents, let me be clear, I mean, what Mr. McLennan just said is that we could get around this by not asserting the '378 patent, which is the later-issuance patent, and therefore claim the full period of damages, but the issue is that the '378 patent is the broadest patent. And so under some of our infringement theories we would -- there is a lot more infringement of the

'378 than others. So what we are basically being asked to do is choosing between our broadest patent that issued later, and so we can't get damages for the first part of the pandemic, on the one hand, or asserting a narrower patent which is less infringed under some of our theories but covers the whole period. We shouldn't have to make choices like that with our property rights. That doesn't seem right.

And I'm happy to give further analysis. For example, on the issue of preclusion and estoppel, there are three different buckets into which these patents might fall. The '069 everyone agrees they are precluded, obviously. The '435 we think their statutory forum is precluded; they don't. The other three patents we think they are precluded from argument based on common law estoppel; they don't.

And so again, we're having to choose from different categories for no reason. In both cases there are six claims that the jury is getting. It's not going to make a difference to the jury whether those six claims come from two, three, or four patents. It's the same infringement theories but just that the results are different.

THE COURT: You made that argument already. I heard you.

Mr. McLennan, do you agree that if I allow more patents it won't elongate the trial?

MR. McLENNAN: Your Honor, so to take us back to where

we started with this we when had the hearing a couple weeks ago, we were asked to propose narrowing before summary judgment and trial. That's exactly what we've done. So in terms of the trial, maybe, you know, the focus on whether it's going to make a difference at trial is one thing, but I think we also need to think about the burden on the parties and the Court going through summary judgment and *Daubert*. And what I essentially hear is they want to keep all six patents through summary judgment and *Daubert*. We laid out in our letter today --

THE COURT: Mr. McLennan, could you answer my question?

MR. McLENNAN: Apologize, Your Honor. You are asking us to give a different analysis for the Court -- or the jury --

THE COURT: No, I'm asking, in your view, if I allow more than three patents in -- Mr. Berl is saying it's not going to affect the length of the trial, the length of the trial is going to be affected by the claims, not the number of patents. Do you agree or disagree?

MR. McLENNAN: I disagree. We do have different defenses across different patents, so I do think it increases the complexity across the trial.

MR. BERL: Your Honor, they listed which defenses -- which claims their defenses are applicable to. Most of their defenses they said are applicable to all of the claims.

THE COURT: Most of them. But my takeaway, you know,

with this discussion, and I could have gotten the wrong impression, but I suggested -- my memory -- let's lay out on *Daubert* -- to try to economize the thing, let's lay out everyone's opinion so we can figure out what to do with *Daubert*, and then I take, you know, whatever motions for summary judgment. I thought both sides were like no, no, no, no, narrow, narrow first, and then we can talk about that. But so now I've done that, and I guess Arbutus is having a different view.

All right. This discussion has been helpful.

Did you want to say anything else, Mr. Berl?

MR. BERL: No, Your Honor.

THE COURT: Okay. All right. Let me mull this over a little bit and I'll -- when is this -- when is this narrowing due?

MR. BERL: It would be due today, Your Honor.

THE COURT: You are not obligated to submit any -- I want to think about this, so I'm giving a verbal order -- I'll put it in writing, but you can tell your team you don't have to submit anything today. I'm going to try to issue an order -- I got a lot going on today and tomorrow, but you will hear from me on this by the end of close of business tomorrow, and I'll give you some time to figure out what to do. So don't worry about the deadlines for today. That's off the table.

MR. McLENNAN: Thank you, Your Honor.

MR. BERL: I appreciate that, Your Honor.

THE COURT: Thank you. Take care.

(Proceeding concluded at 3:29 p.m.)

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I certify that the foregoing is a correct transcript from the record of proceedings in the above-entitled matter.

/s/ Cherilyn M. McCollum

Cherilyn M. McCollum, CCR, RPR
Official Court Reporter

Date: 23rd day of May, 2025